

REMARKS

Claims 23-38 remain pending in the present application. None of the claims have been amended.

REJECTION UNDER 35 U.S.C. §103(a)

The Examiner has rejected Claims 23-38 under 35 U.S.C. §103(a) as being unpatentable over Mooty et al. (U.S. Patent No. 6,656,626) in view of Maeda et al. (U.S. Patent No. 5,189,570). The Examiner alleges that this combination would render Applicants' claims obvious to those skilled in the art.

Applicants' claim relates to a power tool housing having a mechanism for ejecting a battery pack. The mechanism includes, among other elements, a cavity in the frame for receiving a battery pack at the distal end of the handle portion and a biasing member in the cavity. The biasing member ejects the battery pack from the receiving member. The battery pack is received in the member so that the battery pack is in contact with the biasing member such that when the battery pack is secured on the frame, the biasing member is in a compressed condition and when the battery pack is released from the frame, the biasing member (in an expanded condition) ejects the battery pack from the frame.

The Examiner alleges that Mooty et al. in view of Maeda et al. would render Applicants' claims obvious to those skilled in the art.

The Examiner, in his remarks, in Paragraph 4 states the following:

a cavity (114 opening) in the frame for receiving a battery pack (108) at the distal end of the handle portion (104); a member (116, 119) for receiving a member (152, 155) on the battery pack (108) to couple the battery pack with the power tool (100); a biasing member (125, 130) in the cavity (114), the biasing member (125,

130) for ejecting (releasable) the battery pack (108) from the receiving member (116, 119); and the battery pack (108) received in the receiving member (116, 119) so that the battery pack is in contact with the biasing member (125, 130).

The Examiner followed that the reference to Mooty et al. discloses the claimed subject matter but lacks a specific teaching of the battery pack secured on the frame and in contact with the biasing member in a compressed condition.

The Examiner has totally mischaracterized the Mooty et al. reference. In fact, Mooty et al. illustrates a biasing member 125 buried in the handle portion of the drill, as illustrated in Figs. 7a and 7b. In no way does the biasing member contact the battery pack as claimed by Applicants. Likewise, the closure member 130 is buried in the housing with a rigid portion blocking the guide channel. Thus, the alleged biasing element of Mooty is not as claimed by Applicants. Further, the Mooty et al. reference operates exactly opposite to Applicants' claims. In Mooty et al., the spring is extended when the battery is locked in the housing. The spring is compressed when the battery is allowed to be removed. Further, the battery is not ejected from the housing by the biasing member. The battery must be physically removed after the locking mechanism has been moved to a released position. This is unlike Applicants' claims.

The Examiner then combines Mooty et al. with the Maeda et al. reference. Maeda et al. illustrates a magnetic head advancing/retracting device for rotating magnetic recording media. The device includes a mechanism to automatically eject a battery pack when the device senses a lower power level. Thus, the battery pack is not ejected by the user. The only way the battery pack is ejected is when a low battery level reading is sensed.

Further, there is no teaching in the references of how Maeda et al. would be combined with the Mooty et al. reference. In order to modify the Mooty et al. biasing mechanism to eject the battery pack as claimed by Applicants, the locking mechanism of Mooty et al. would have to be significantly altered which, in turn, would render it incapable of performing its intended purpose of locking the battery in place.

Clearly, this is a wholesale hindsight reconstruction. The reconstruction is illustrated by the fact that Mooty et al. needs to be significantly modified to accomplish Applicants' claims while destroying the intended purpose of Mooty et al. It is clear that once the intended purpose of Mooty et al. is destroyed by the Examiner's combination to read on Applicants' claims, Mooty et al. in combination with Maeda et al. is improper under 35 U.S.C. §103.

The Examiner has failed to provide any logical reasoning as to why this is the case. The Court requires the Board (Examiner):

"to explain the reasons one of ordinary skilled in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. This entails consideration of both the scope and content of the prior art and the level of ordinary skill in the pertinent art. When the Board (Examiner) does not explain the motivation, or the suggestion or teaching, that would have lead the skilled artesian at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious." In re Kahn, 78 USPQ2d 1329 (1334-1335).

"To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reason basis to explain why the conclusion of obviousness is correct." In re Kahn, supra, at 1336.

Here, the Examiner has provided a naked conclusion with no rationale or reasoning as to one skilled in the art, after reviewing the two references as whole, would come to this conclusion.

The Court further stated:

"Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness." This requirement ... ensures due process and non-arbitrary decision making as it is in §103. Id. at 1336

Thus, the Examiner's lack of reasoning and rationale fails to meet the standard of a proper §103 rejection. Accordingly, by providing only a mere conclusory statement, the Examiner's rejection cannot stand.

Thus, Applicants would submit that all pending claims are in condition for allowance. Accordingly, Applicants respectfully request the Examiner to pass the case to issue at his earliest possible convenience.

Should the Examiner have any questions regarding the present application, he should not hesitate to contact the undersigned at (248) 641-1600.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'W.R. Duke Taylor', written over a horizontal line.

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